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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Arnaud Brun

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NEW YORK, NY 10176

EXAMINER

ELAHEE, MD S

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,937	Applicant(s) BRUN ET AL.	
	Examiner MD S. ELAHEE	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/19/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 01/07/2008. Claims 1-16 are pending.

Response to Arguments

2. Applicant's arguments filed in 01/07/2008 Remarks regarding claims 1-11 have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.
3. Applicant's arguments in the 01/07/2008 Remarks regarding claims 12-16 have been fully considered but they are not persuasive because of the following:

Regarding claim 12, the applicant argues regarding the added limitation on pages 9-11 that Barker does not disclose "said sound content being previously produced at the telephone terminal without requiring connection of the telephone terminal to a remote telecommunications device, and wherein said storage entity extracts the sound content contained in the message". Examiner respectfully disagrees with this argument. In page 2, paragraph 0023, page 5, paragraph 0082, Barker discloses that the sender can dictate the message by speaking into a microphone and after completing the message, the message is transmitted to a playback server [i.e., storage entity]. It clearly means that the sound content being previously produced at the sender's telephone terminal without requiring connection of the telephone terminal to a remote telecommunications device. The sender types in the message the desired date and time for

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delivery of the message (see page 5, paragraph 0079. When the delivery time comes, the server sends the audio message to the recipient. It clearly means that the server extract the sound content from the message. In other word, the storage entity extracts the sound content contained in the message.

Thus, the rejection of the claim will remain.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 12, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Barker (U.S. Pub. No. 2002/0172331).

Regarding claim 12, with respect to Figures 1-4, 7-10, Barker a telecommunications device for making available a message [i.e., sound content] addressed to at least one telephone terminal holder, the device comprising

a call compilation device 140 in Fig.1 [i.e., sound content receiver entity] and a playback device 150 in Fig.1 [i.e., sound content storage entity] consultable by telephone wherein the

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sound content receiver entity are configured to read a message which is precomposed on a telephone terminal before said message is sent from the telephone terminal and to store the sound content included in said message in memory in a consultable form, said sound content being previously produced at the telephone terminal without requiring connection of the telephone terminal to a remote telecommunications device, and wherein said storage entity extracts the sound content contained in the message (abstract; page 1, paragraphs 0019-0021, page 2, paragraphs 0022-0024, 0026-0028, page 4, paragraphs 0058, 0064, 0067, page 5, paragraphs 0076, 0079-0082).

Regarding claim 15, Barker, as applied to claim 12, teaches that the message receiver entity and the sound content storage entity for storing the sound content included in the message in memory in the consultable form are configured to read an MMS message and to store sound content included in the MMS message in a form that is consultable by telephone (page 2, paragraphs 0023, 0026, 0027, page 4, paragraphs 0064, 0067, page 5, paragraphs 0079-0082).

Regarding claim 16, Barker, as applied to claim 15, teaches that the sound content receiver entity comprises means for reading an MMS message for identifying and extracting coordinates of at least one recipient included in said MMS message, and for sending the sound content of the MMS message to at least one storage entity corresponding to coordinates of a recipient (abstract; page 2, paragraphs 0023, 0026, 0027, page 4, paragraph 0064, page 5, paragraph 0076).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 2, 5-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker (U.S. Pub. No. 2002/0172331) in view of Oren (U.S. Pub. No. 2003/0169865).

Regarding claim 1, with respect to Figures 1-4, 7-10, Barker teaches a method of making a sound content available, the method comprising the steps of:

producing the message [i.e., sound content] and sending it by means of a telephone terminal and receiving and storing said sound content with a view to subsequent consultation by a telephone terminal (abstract; page 1, paragraphs 0019-0021, page 2, paragraphs 0022-0024, 0026-0028, page 4, paragraphs 0058, 0064, 0067, page 5, paragraphs 0076, 0079-0082),

However, Barker does not specifically teach storing said sound content with a view to subsequent consultation by a second telephone terminal. Oren teaches storing said sound content with a view to subsequent consultation by a second telephone terminal (fig.6; page 4, paragraph 0032). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barker to incorporate the feature of storing said sound content with a view to subsequent consultation by a second telephone terminal in Barker's invention as taught by Oren. The motivation for the modification is to do so in order to store message in a server for a called party such that the message can be delivered to a destination based on the choice of the called party from where he can easily retrieve the message remotely within a short period of time.

Barker further teaches wherein the producing of the sound content at the first telephone terminal precedes and is temporally separate from said sending of the sound content by the first telephone terminal, said sound content being included in a message as an element of the message and wherein said producing of the sound content is performed without requiring connection of

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the first telephone terminal to a remote device (abstract; page 2, paragraphs 0022-0024, 0026-0028, page 4, paragraphs 0058, 0064, 0067, page 5, paragraphs 0076, 0079-0082).

Regarding claim 2, Barker, as applied to claim 1, teaches that producing the sound content includes the production of a voice content included in the sound content (abstract; page 2, paragraphs 0022-0024, 0026-0028, page 4, paragraphs 0058, 0064, 0067, page 5, paragraph 0076).

Regarding claim 5, Barker, as applied to claim 1, teaches that the producing the sound content comprises composing an MMS message including the sound content (page 2, paragraphs 0023, 0026, 0027, page 4, paragraphs 0064, 0067, page 5, paragraphs 0079-0082). (Note; Barker teaches that audio/text greeting is included with audio track and recipient's name, telephone number. It clearly means that Barker teaches composing an MMS message including the sound content.)

Regarding claim 6, Barker, as applied to claim 5, teaches that the MMS message contains an element comprising the sound content and an element comprising the coordinates of at least one recipient of the sound content (page 2, paragraph 0023, page 4, paragraphs 0064, 0067, page 5, paragraphs 0079-0082).

Regarding claim 7, Barker, as applied to claim 6, teaches that the coordinates of the at least one recipient of the sound content are telephone coordinates (page 2, paragraph 0023, page 4, paragraphs 0064, 0067, page 5, paragraphs 0079-0082).

Regarding claim 10, Barker, as applied to claim 1, teaches that said producing the sound content comprises modifying a voice recording using sound processing functions provided by the first telephone terminal (page 2, paragraph 0023, page 4, paragraphs 0064, 0067, page 5, paragraphs 0079-0082).

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barker in view of Oren further in view of Allen et al. (U.S. Patent No. 5,313,515).

Regarding claim 3, Barker, as applied to claim 1, teaches that the storing the sound content for subsequent consultation comprises in depositing the message in a telephone user's storage means as a message for that user and wherein the sound content is stored in memory (page 2, paragraphs 0023, 0026, page 4, paragraph 0064, page 5, paragraph 0076).

However, Barker in view of Oren does not specifically teach depositing the message in a voice mailbox of a telephone user. Allen teaches depositing the message in a voice mailbox of a telephone user (fig.1; col.1, lines 53-63, col.2, lines 23-55). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barker in view of Oren to incorporate a telephone user's voice mailbox in Barker's invention in view of Oren's invention as taught by Allen for depositing the message. The motivation for the modification is

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to do so in order to store message in an assigned mailbox for a user such that the user can easily retrieve the message by accessing the mailbox remotely within a short period of time.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barker in view of Oren further in view of Tuttle (U.S. Patent No. 6,912,271).

Regarding claim 4, Barker, as applied to claim 1, teaches that the storing the sound content for subsequent consultation comprises recording the message in an entity for sending a greeting for a user, and wherein the sound content is stored in memory (abstract; page 2, paragraphs 0023, 0026, 0027, page 4, paragraph 0064, page 5, paragraph 0076).

However, Barker in view of Oren does not specifically teach an entity for sending a voicemail greeting for a voice mailbox as the voicemail greeting of that voice mailbox. Tuttle teaches an entity for sending a voicemail greeting for a voice mailbox as the voicemail greeting of that voice mailbox (col.2, lines 44-48, 59-67, col.3, lines 1-7, col.9, lines 21-46, 57-62). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barker in view of Oren to incorporate an entity in Barker's invention in view of Oren's invention as taught by Tuttle for sending a voicemail greeting for a voice mailbox as the voicemail greeting of that voice mailbox. The motivation for the modification is to do so in order to deliver a particular greeting message to a particular recipient such that the recipient can only receive specific message important for him instead of receiving a generic message.

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10. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker in view of Oren further in view of Sauer (U.S. Pub. No. 2005/0212659).

Regarding claim 8, Barker, as applied to claim 6, teaches that the element comprising the coordinates of the at least one recipient (page 2, paragraphs 0023, 0026, 0027, page 4, paragraph 0064, page 5, paragraph 0076).

However, Barker in view of Oren does not specifically teach that the element comprising the coordinates of the at least one recipient contains the coordinates of a plurality of recipients. Sauer teaches the element comprising the coordinates of the at least one recipient contains the coordinates of a plurality of recipients (abstract; page 1, paragraph 0009, page 2, paragraph 0019). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barker in view of Oren to incorporate an element in Barker's invention in view of Oren's invention as taught by Sauer for containing the coordinates of a plurality of recipients. The motivation for the modification is to do so in order to deliver a particular message to multiple recipients such that the multiple recipients can receive the particular message important for them from a particular sender.

Regarding claim 9, Barker in view of Oren, as applied to claim 6, does not specifically teach that storing the sound content in a series of voice mailboxes of different recipients based on said element comprising coordinates of the at least one recipient. Sauer teaches storing the sound content in a series of voice mailboxes of different recipients based on said element comprising coordinates of the at least one recipient (abstract; page 1, paragraph 0009, page 2, paragraphs

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0019, 0026, page 3, paragraphs 0027, 0031, 0032, 0036). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barker in view of Oren to incorporate the feature of storing the sound content in a series of voice mailboxes of different recipients based on said element comprising coordinates of the at least one recipient in Barker's invention in view of Oren's invention as taught by Sauer. The motivation for the modification is to do so in order to deliver a particular message to a multiple recipients' mailboxes such that the multiple recipients can receive the particular message important for them at their own convenience.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barker in view of Oren further in view of Hoisko et al. (U.S. Pub. No. 2002/0082007).

Regarding claim 11, Barker in view of Oren, as applied to claim 10, does not specifically teach that said producing the sound content comprises producing a voice recording in a memory of the first telephone terminal and superimposing at least one sound content prestored in the memory of the first telephone terminal on the voice recording. Hoisko teaches that said producing the sound content comprises producing a voice recording in a memory of the first telephone terminal and superimposing at least one sound content prestored in the memory of the first telephone terminal on the voice recording (abstract; fig.6; page 2, paragraphs 0018, 0019, page 3, paragraphs 0027, 0030, 0031, page 4, paragraphs 0034, 0035, 0038). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barker in view of Oren to incorporate the feature of producing the sound content comprises

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producing a voice recording in a memory of the first telephone terminal and superimposing at least one sound content prestored in the memory of the first telephone terminal on the voice recording in Barker's invention in view of Oren's invention as taught by Hoisko. The motivation for the modification is to do so in order to compose a particular message from locally stored message elements such that a caller can easily compose a message locally within a short period of time instead of accessing remote message sources.

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barker in view of Allen et al. (U.S. Patent No. 5,313,515).

Regarding claim 13, Barker, as applied to claim 12, does not specifically teach that the storage entity is a voice mailbox of a telephone user. Allen teaches that the storage entity is a voice mailbox of a telephone user (fig.1; col.1, lines 53-63, col.2, lines 23-55). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barker to incorporate the storage entity as a telephone user's voice mailbox in Barker's invention as taught by Allen. The motivation for the modification is to do so in order to an assigned mailbox for a user for depositing the message such that the user can easily retrieve the message by accessing the mailbox remotely within a short period of time even when the user is traveling.

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barker in view of Tuttle (U.S. Patent No. 6,912,271).

Claim 14 is rejected for the same reasons as discussed above with respect to claim 4.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fan Tsang/

Supervisory Patent Examiner, Art Unit 2614

/M. E./

MD SHAFIUL ALAM ELAHEE

Examiner

Art Unit 2614

April 15, 2008